

DOCKET NO.: ABI-0042
Application No.: 10/010,659
Office Action Dated: September 9, 2004

PATENT

REMARKS

Claims 1-17 are pending in the application and have been rejected in the outstanding Office Action. Reconsideration of the Office Action of September 9, 2004 and allowance of the above-captioned patent application is respectfully requested in view of the following remarks.

Interviews were conducted between Examiner Lyle Alexander of the USPTO and Applicant's representative, Mr. Michael Jones, on November 19, 2004 and November 22, 2004. The following is a summary of these two Interviews. During the Interviews, the features of the independent claims 1, 10, and 16 were discussed with reference to the art of record. After hearing Applicants arguments, as detailed in the remarks section below, and reconsideration, the Examiner indicated that the claims were in condition for allowance.

Abstract:

In the telephone interview on November 22, 2004, the Examiner objected to the Abstract as being longer than 15 lines. The Abstract has been amended to shorten it to 15 lines.

Information Disclosure Statement:

The Office Action includes an initialed copy of the Form PTO-1449, however not all of the references cited on the Form PTO-1449 have been initialed by the Examiner. The Examiner has annotated on the Form PTO-1449 that copies of certain references cited therein were not provided or supplied. These documents include documents cited as AA, AB, AC, BL, and BM.

During the interview on November 22, 2004, the Examiner indicated that he had review the parent application (patent application serial no. 09/321,311 filed May 27, 1999 – the “311 application”) of the present application and had found copies of the documents cited as AA, AB, AC, BL, and BM in the Form PTO-1449 of the present application. The present application is a continuation of the 311 application and copies of the noted documents were

DOCKET NO.: ABI-0042
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Office Action Dated: September 9, 2004

PATENT

submitted with a Form PTO-1449 during prosecution of the 311 application (see, 37 C.F.R. 1.98(b)(3)).

The Examiner indicated that he had considered the above noted references and initialed the Form PTO-1449 and would provide an initialed copy of Form PTO-1449 with the next communication from the PTO regarding this case.

Claims Rejections under 35 U.S.C. § 102(b):

Claims 1-4, 7-13, 16, and 17 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent Number 5,460,783 (Hautea et al.) or U.S. Patent Number 5,540,889 (Gordon et al.). It is respectfully submitted that claims 1-4, 7-13, 16, and 17 are allowable over the art of record for the reasons set forth below.

The standard for anticipation under 35 U.S.C. §102(b) is one of strict identity. An anticipation rejection requires a showing that each limitation of a claim be found in a single reference, *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

Hautea et al. and Gordon et al. do not disclose an apparatus and method for accurately locating a multi-well plate at a plate-support location of an automated machine such that one or more members can operate on the individual wells of the plate, *"wherein one or more of said at least one projection and said exterior wall surfaces of one or more wells have complementary shaped regions, with said engaging taking place between said at least one projection and said complementary shaped regions of said wells when said microtiter plate is positioned on said plate-support surface"*, as recited in claim 1.

Also, Hautea et al. and Gordon et al. do not disclose *"a central cavity formed at a distal end of each of said at least one projection, wherein said central cavity extends from said distal end of said projection toward said plate support surface and opens away from said plate-support surface, said cavity being configured to receive at least a lower region of said exterior wall surfaces of a well"*, as recited in claim 4 and claim 16.

In addition, as recited on claim 10 the instant invention is drawn to a microtiter system comprising a plate and an acting-member support with one or more sample-handling or reading members which are adapted to operate on individual wells in the micro-plate when disposed upon a plate-support surface. A control unit controls the position of the acting-

Page 4 of 6

DOCKET NO.: ABI-0042
Application No.: 10/010,659
Office Action Dated: September 9, 2004

PATENT

member support with respect to defined coordinates on the plate support surface. While many automated sample dispensing machines for use with microtiter plates exist, none of the prior art teaches the acting-member which comprises a locator structure depending therefrom for engaging the interior wall surfaces of one or more wells of the microtiter plate when introduced therein, to fix the position of one or more unengaged wells in alignment with the one or more sample-handling or reading members. Hautea et al. and Gordon et al. do not disclose these features. Gordon et al. teach a microtiter plate with exterior wall surfaces, a plate handling machine having a plate support surface 50 and sample-handling device 12 which operates on individual wells, a controller 18 for controlling the position of the acting-member support 10 and a locator structure 52 disposed on the acting-member support for engaging interior wall surfaces of one or more wells 56 of the plate support surface 50, not the wells of the microtiter plate itself, see Figs. 1A and 2.

Furthermore, Hautea et al. and Gordon et al. do not disclose "*wherein each of said central cavities of said one or more projections and said exterior wall surfaces of one or more wells have complementary shaped regions, with said engaging taking place between said central cavities and said complementary shaped regions of said exterior wall surfaces of said wells when said microtiter plate is positioned on said plate-support surface*", as recited in claim 17.

Since Hautea et al. and Gordon et al. do not disclose all of the features of the claimed invention, there can be no anticipation under 35 U.S.C. §102(b), and accordingly, withdrawal of this rejection of claims 1-4, 7-13, 16, and 17 is respectfully requested.

Claims Rejections under 35 U.S.C. § 103(a):

The Examiner has rejected claims 5, 6, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Hautea et al. or Gordon et al. in view of U.S. Patent No. 6,063,579 (Bevirt et al.). Applicants respectfully traverse the rejections under 35 U.S.C. § 103(a) and submit that no single reference or proper combination of the references of record would yield Applicants' unique invention, as recited in the claims of the present invention.

In the Office Action, claims 9, 10, and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hautea et al. or Gordon et al. in view of Bevirt et al. (U.S. 6,063,579). This rejection is respectfully traversed.

Page 5 of 6

DOCKET NO.: ABI-0042
Application No.: 10/010,659
Office Action Dated: September 9, 2004


PATENT

As stated above, Hautea et al. do not disclose or teach the features of claims 1, 4, 10, 16, and 17. Bevirt et al. do not correct the deficiencies of the Hautea et al. and Gordon et al. references because it does not disclose, teach, or suggest the features recited above and claimed in the present application. Since claims 4 and 5 depend from claim 1 and claims 14 and 15 depend from claim 10, it is respectfully submitted that they are also in condition for allowance. Accordingly, withdrawal of this rejection under 35 U.S.C. § 103(a) is respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicants submit that the above-identified application is in condition for allowance. Early notification to this effect is respectfully requested.

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